



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/728,951

12/08/2003

Kouichi Sugiyama

00862.023356.

9003

5514 7590 10/04/2007
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

THOMAS, ASHISH

ART UNIT

PAPER NUMBER

2625

MAIL DATE

DELIVERY MODE

10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/728,951

Applicant(s)

SUGIYAMA, KOUICHI

Examiner

Ashish K. Thomas

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/16/04

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato(EP 1,162,824 A2) in view of Fischer(U.S. 6,373,588).

Regarding claim 1, Sato discloses a method of controlling printing in a printing system having a function for combining multiple print jobs comprising(**Column 12, lines 34-40**): a combination step of combining the multiple items of print data into a single item of print data(**Column 12, lines 34-40 discloses a method that combines the plurality of print jobs.**); and an output step of outputting the print data that has been combined(**Column 12, lines 20-25 details that a plurality of print jobs are collectively outputted.**).

However, Sato is silent on a method of controlling printing in a printing system having a banner printing function comprising: a processing step for processing the data for banner printing separately of multiple items of print data when multiple print jobs that include banner printing are combined and prescribed manipulation settings are specified; and an output step of outputting the data for the banner printing processed at said processing step.

Fischer, on the other hand, discloses a method of controlling printing in a printing system having a banner printing function comprising(**Figure 1 teaches a banner page manager 60.**): a processing step for processing the data for banner printing separately of multiple items of print data when multiple print jobs that include banner printing are combined and prescribed manipulation settings are specified(**Column 10, lines 13-25 implies that the banner printing is performed separately. For example, this reference states that a banner page is processed only after all the copies are detected.**); and an output step of outputting the data for the banner printing processed at said processing step(**Column 10, lines 20-25 describes a step that outputs the banner page.**).

Therefore it would have been obvious for one of ordinary skill in the art, at the time of the present invention, to modify Sato with Fischer to fully realize the method claimed in claim 1.

The motivation is to devise not only an efficient system but also a system that provides a clear and concise banner page by printing only one banner page for a plurality of print jobs.

Regarding claim 2, Fischer discloses the method wherein the data for banner printing is deleted and a single item of data for banner printing is created anew at said processing step(**Column 10, lines 19-22 describes rather than printing a plurality of banner sheets, only one banner sheet is page. This implies the deletion of some banner data and the creation of a new page.**).

Regarding claim 3, Sato teaches the method wherein the prescribed manipulation setting are specified with respect to the combined print data(**Column 11, lines 10-24 of Sato details some settings that affect the combined print jobs. In addition, Fischer in column 4, lines 18-40, describe this sort of settings as well.**).

Regarding claim 4, Fischer discloses the method wherein the prescribed manipulating settings are at least finishing settings or layout settings(**Column 4, lines 18-40 of Fischer teaches finishing settings such as stapling, binding, and so on.**).

Regarding claim 5, Fischer teaches The method wherein the data for banner printing processed at said processing step and the combined data are output as a single print job at said output step. (**Column 10, lines 13-25 of Fischer teaches that the numerous copies of the print job are outputted to a single output tray and only one banner sheet is used instead of a plurality of banner sheets. All this information is indicative of a single print job as stated in the claim language.**)

Regarding claim 6, it is rejected in the same manner as claim 1 since it claims a system that incorporates the method claimed in claim 1.

Regarding claim 7, it is rejected in the same manner as claim 1 since it claims an apparatus that incorporates the method claimed in claim 1.

Regarding claims 8 and 9, they are rejected in the same manner as claim 1 since they claim a computer readable medium storing a computer program that actually realizes the method claimed in claim 1.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Art Unit: 2625

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 8-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 8, it is claiming a computer program as opposed to a computer readable medium that stores a computer program. Please note that a computer program is an example of non-statutory subject matter.

Regarding claim 9, is depends on a rejected base claim.

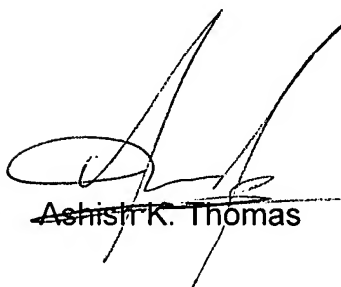
Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashish K. Thomas whose telephone number is 571-272-0631. The examiner can normally be reached on 9:00 a.m. - 5:30 p.m. EST.

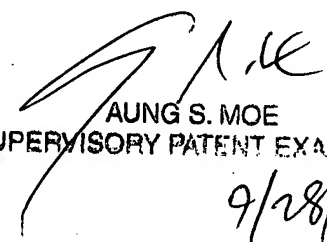
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Aung S. Moe can be reached on 571-272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ashish K. Thomas



AUNG S. MOE
SUPERVISORY PATENT EXAMINER
9/28/07